

REMARKS

The Title has been changes such that it is more indicative of the claimed invention.

The claims have been amended to more clearly define the invention as disclosed in the written description. In particular, the claims have been amended for clarity.

The Examiner has rejected claims 6 and 7 under 35 U.S.C. 101 in that the claimed invention is directed to non-statutory subject matter.

Applicants have amended claim 6 to indicate that the record carrier is in the form of a computer-readable medium having a digital information signal recorded thereon. The digital information signal comprises two video signals producing different sized images.

Applicants contend that the digital information signal forms functionally descriptive material which when processed on a computer system is capable of providing a displayed image including the first video signal overlaid by the second video signal, or alternatively, two separate displayed images. When this functional descriptive material is recorded on a computer-readable medium, then such a combination is statutory subject matter.

The Examiner has rejected claims 6, 8 and 9 under 35 U.S.C. 102(b) as being anticipated by Korean Patent Document KR2001004940 to Jo. The Examiner has further rejected claims 1, 3 and 5 under 35 U.S.C. 102(b) as being anticipated by either U.S. Patent 6,741,617 to Rosengren et al., or U.S. Patent Application

Publication No. 2002/0047915 to Rosengren et al. In addition, the Examiner has rejected claim 4 under 35 U.S.C. 103(a) as being unpatentable over either the Rosengren et al. patent or the Rosengren et al. publication.

Applicants acknowledge that the Examiner has found claim 2 allowable over the prior art of record.

The Jo patent discloses a video object with pip (picture in picture) type moving picture advertisement being carried; fabrication and distribution method of the same, in which a first and second video signals are generated, the second video signal is processed as to size and shape, the first video signal and the processed second video signal are then mixed forming a mixed such that the processed second video signal at a predetermined position in the first video signal thereby forming a mixed video signal, and the mixed video signal is stored in a record medium.

As noted in MPEP § 2131, it is well-founded that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of

terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claim 6 includes the limitation "the digital information signal comprising a first video signal and a second video signal, characterized in that the first video signal represents a sequence of images having a first size, and the second video signal represents a sequence of images having a second size, the second size of the images being smaller than the first size".

Applicants submit that the mixed video signal of Jo is not equivalent to the digital information signal as claimed in claim 6. In particular, while the mixed video signal of Jo is formed by mixing a first video signal and a processed second video signal, when the two signals are mixed, a portion of the first video signal is necessarily replaced by the processed second video signal. This replaced portion of the first video signal is then lost and is not recoverable.

In the subject invention, the digital information signal comprises a first video signal and a second video signal. Each of these video signals are fully intact and may be recovered from the digital information signal.

Claim 8 includes the limitation "the signal combination means combining the first video signal and the processed second video signal while retaining all video information in the first and processed second video signals so as to form said digital information signal".

Applicants submit that this distinguishes the signal combination means of the subject invention from the mixing being done in element 12 of Jo in order to form a mixed video signal for display.

The Rosengren et al. patent discloses an arrangement for decoding digital video signals.

The subject invention, as claimed in claim 1, includes the limitations "second retrieval means for retrieving said second video signal from the received digital information signal" and "the first video signal represents a sequence of images having a first size, and the second video signal representing a sequence of images having a second size, the second size being smaller than the first size of the images".

The Examiner has indicated that Rosengren et al. describes "A second retrieval means (e.g., @ 60) for receiving and retrieving a second video signal (@ V2) from the digital information signal wherein the second video signal (@ V2) comprises:

- a) In a first embodiment, a full size image signal, that converted/scaled at the receiver (@ 63) to a video signal (@ V2') representing reduced size PIP images [e.g., lines 14-23 of column 5]; or
- b) In a second embodiment, an ancillary video signal that has already been converted scaled on the transmitter side of the system (e.g., @51 of Figure 5) so as represent the reduced sized PIP images [e.g., lines 23-26 of column 5]; wherein the recitations of claim 6 [sic] are met by this second embodiment".

Applicants submit that the Examiner is mis-reading Rosengren et al. in an attempt to find the claimed invention. In particular, Rosengren et al., at col. 5, lines 23-28 states "In a second embodiment of the PIP-receiver, the elementary stream V2 is assumed to be an ancillary video stream transmitted by an arrangement as shown in FIG. 5. As explained with reference to FIG. 5, the elementary stream V2 comprises DC-coefficients of I-pictures only." The Fig. 5 embodiment is described at col. 4, lines 53-57 "The main video signal Vm is applied to transcoder 51 which may take the form of the arrangement shown in FIG. 3, already discussed. The transcoder outputs an ancillary video signal Va in the form of a further elementary stream." Now, referring to col. 4, lines 25-32, Rosengren et al. states "The arrangement shown in FIG. 3 thus copies the main bitstream Vm in memory 30, thereby ignoring the P- and B-pictures as well as the non-DC-coefficients of I-pictures. The ancillary video signal Va obtained by reading out the memory 30 is the same as that created by the arrangement shown in FIG. 1 but is now suitable for transmission as a further elementary signal. It is a low bitrate replica of the main signal, with a reduced spatial and temporal resolution.".

It should be apparent from the above that while Rosengren et al. discloses that the second video signal may be an auxiliary video signal absent P- and B-pictures, and having reduced spatial and temporal resolution, there is no disclosure that the size of an image formed by the auxiliary video signal is reduced. In fact, Rosengren et al. particularly states, with regard to the embodiment

of Fig. 6 "In this embodiment, PIP-decoder 63 also takes the form of the circuit shown in FIG. 1, already discussed." Hence, the auxiliary video signal still must need to have its size reduced by the PIP decoder 63.

In the subject invention, the second video signal as retrieved from the digital information signal already has a second size smaller than a first size of the first video signal.

It is unknown to Applicants why the Examiner cited and used USPAP 2002/0047914 to Rosengren et al. in that this is merely the published patent application which matured into the Rosengren et al. patent. Hence, Applicants' above arguments concerning the Rosengren et al. patent are applicable to the Rosengren et al. publication.

In view of the above, Applicants believe that the subject invention, as claimed, is neither anticipated nor rendered obvious by the prior art, and as such, is patentable thereover.

Applicants believe that this application, containing claims 1-9, is now in condition for allowance and such action is respectfully requested.

Respectfully submitted,

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